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Status of Claims:

Claims 1-20 are rejected. Claims 1 and 10 are amended. Claims 14 and 15 are canceled. Claims 1-13 and 16-20 remain pending.

The amendments are supported by the specification, claims, and figures as originally filed. No new matter is added.

§ 102 Rejections:

Claims 1, 3, 7, and 9-13 are rejected as anticipated by Gregoire (5944673). It is respectfully urged that this rejection is improper for at least the following reasons.

First, Claim 1 is amended to recite, among other things, that the cutter has a plurality of holes spaced from the distal end of the cutter, and wherein the holes are positioned for providing vacuum axially through the cutter when multiple tissue samples are disposed within the sample tube within the cutter. It is respectfully urged that Gregoire does not teach or suggest such a cutter.

Second, Claim 1 recites, among other things, a sample tube having an open distal end. Gregoire at column 7, lines 1-10 discloses an extractor 65 having a closed distal end plate 67.

Accordingly, Gregoire does not anticipate Claim 1 as amended.

Further, one would not be motivated to modify Gregoire to include all the limitations of Claim 1. For instance, providing an open distal end in Gregoire's extractor 65 would be counter to the operation of Gregoire's extractor 65. Gregoire teaches that the tissue receptacle 70 is defined by the outer diameter of distal end plate 67 and a distal wall 71 of the distal end plate 67 (see Column 7, lines 25-30 of Gregoire.)

Withdrawal of the rejection of Claim 1 and all claims depending from Claim 1 is requested.

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Regarding Claim 10 as amended, it is respectfully urged that Gregoire does not teach a sample tube having a vacuum lumen and a sample lumen, wherein the vacuum lumen extends along side of at least a portion of the sample lumen, as shown in the drawings as filed.

With respect to Claim 11 and claim 12, it is respectfully urged that the Examiner has mischaracterized Gregoire. The Examiner states that tissue receptacle 70 of Gregoire is a tube wall feature. It is respectfully urged that one would not consider receptacle 70 a wall feature, or a notch (as recited in Claim 12). Instead, receptacle 70 is described by Gregoire as a concave space, being defined by plate 67, wall 71, a floor 72, and a proximal wall 73 (see column 7, lines 24-30 of Gregoire). It is respectfully urged that the receptacle 70 is not fairly cited as a wall feature for retaining tissue samples.

Claim 16:

Claim 16 is rejected as anticipated by Burbank (5526822). This rejection should be withdrawn for at least the following reasons.

The Examiner states that Burbank's tubular knock out pin 92 is a sample tube. It is respectfully urged that this is not a correct characterization of the knock out pin 92 of Burbank, and that Burbank does not teach or suggest that knock out pin 92 serves or could serve as a sample tube for storing a tissue sample.

Burbank, at column 15 lines 12-20 teaches that the distal end of the knock out pin 92 serves to "stop" a tissue sample in a tissue containment chamber as the cutter 68 is withdrawn through the tissue containment chamber. Accordingly, Burbank does not teach pin 92 is a sample tube. Instead, Burbank teaches that the tissue sample does not enter the distal end of the knock out pin 92, but rather is "stopped" by the distal end of the knock pin to be positioned in the containment chamber.

In an alternative embodiment described at column 17, lines 24-51, Burbank describes a biopsy device that has a piercing needle 244 disposed within an outer cutter 268, and a tubular knock out pin 292 movably positioned within the needle 244. Burbank also discloses that in this

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embodiment the end of the knock out pin 292 can be open and the tissue sample can be suctioned through the interior of the knock out pin into a tissue sample receiving area. This embodiment also does not anticipate Claim 16.

First, the embodiment of Burbank employing the knock out pin 292 has a piercing needle disposed within an outer cutter, in contrast to Claim 16, which recites a hollow cutter advancable within a biopsy needle.

Second, the knock out pin 292 does not provide a tissue sample tube that is releasably supported on a biopsy device. Burbank teaches that a tissue sample can be suctioned through the interior of the knock out pin 292 to a tissue sample receiving area. Even if one were to attempt to construe the knock out pin 292 to be a "sample tube", this construction would still not teach or suggest the subject matter of Claim 16 because Burbank does not teach or suggest that the knock out pin 292 is releasably supported to permit the knock out pin to be removed from the biopsy device.

§ 103 Rejections:

Claim 2:

Claim 2 is rejected as obvious over Gregoire et al. in view of Chin 5195533. The Examiner states that Chin teaches multiple samples in an end to end configuration, and states that it would have been obvious to store multiple sample in an end to end configuration in Gregoire.

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It is respectfully urged that this rejection should be withdrawn for at least the following reasons.

Gregoire does not teach or suggest storing multiple samples in the extractor 65. Instead, Gregoire's device, in one embodiment, is configured to hold the tissue sample in the receptacle 70 as the extractor is removed from the probe 45 (column 9, lines 35-48 of Gregoire).

It is respectfully urged that the Gregoire device would not function as the Examiner suggests, even if one attempted to modify Gregoire in view of Chin. It is respectfully urged that once one sample is placed in the tissue receptacle 70 of Gregoire, another sample could not be added to the receptacle 70 without first removing the first sample. Note that even when Gregoire addresses obtaining multiple tissue samples at column 10, lines 1-14, the multiple samples are not stored in

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the extractor 65, since each sample is withdrawn from the receptacle 70 before another sample is taken.

Gregoire describes an alternative embodiment at column 11, lines 20-45, where the samples are withdrawn by vacuum through channel 76. In this embodiment, Gregoire states the extractor is fixed and cannot be removed from the piercing probe, and the proximal wall 73 is removed so that tissue samples can be removed from the probe by vacuum. Referring to column 11, lines 40-45, Gregoire states:

"Once the sample is in the channel 76, it is drawn out of the probe 45 by the continuing application of vacuum."

So, even in this embodiment, when multiple samples are taken, each sample is taken out of the probe, and not stored in the extractor, and the extractor is not releasable from the biopsy probe.

It is respectfully urged that, in view of the above, even if one attempted to modify Gregoire according to Chin, Gregoire would not be operable to store multiple samples in an end to end configuration. For instance, if one attempted to modify Gregorie in view of Chin, it is not seen how a first sample could be taken and kept in the extractor of Gregorie in such a way that the next sample could be received in the extractor. In other words, the first sample, if kept in the receptacle 70 of extractor 65, would interfere with receipt of the second sample. Or alternatively, if the sample is drawn by vacuum through channel 76 and out the probe, it would not be present for end to end stacking.

It is respectfully urged that Chin does not provide guidance on how Gregoire would need to be modified to accomplish end to end stacking within the extractor 65. The Examiner is respectfully urged to withdraw the rejection, or to point out in a non final action specifically how Gregoire would be modified in view of Chin so that the extractor of Gregoire would be operable for receiving and holding multiple samples in an end to end configuration, and such that the extractor would be releasable from the probe.

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Claim 17

Claim 17 is rejected as obvious over Burbank in view of Banik. This rejection is improper for at least the following reasons.

First, the Examiner mischaracterizes the element 92 of Burbank as being a sample tube. The Examiner cites column 17, lines 48-50 to support this characterization. However, this portion of Burbank actually states:

"It (sic) other embodiments, the end of the knock out pin 292 is open and the tissue sample is suctioned through the hollow interior of the tubular knock out pin 292 into a tissue sample receiving area"

It is respectfully urged that the portion of Burbank to which the examiner refers does not support the Examiner's position that the element 92 (or 292) of Burbank is a sample tube, or that tissue is to be positioned in the tube. Instead, the above portion of Burbank referenced by the Examiner merely states that a tissue sample can be suctioned through a knock out pin 292 into a tissue sample receiving area. One reading Burbank would not be motivated to have the tissue sample be positioned in the knock out pin 292 when Burbank teaches that the sample is to be suctioned through the knock out pin 292.

The Examiner admits that Burbank fails to teach or suggest advancing the knock out pin in a cutter to position a sample in the knock out pin, and also that Burbank fails to disclose removing the knock out pin with at least one tissue sample from the device.

It is respectfully urged that it is only by improper hindsight that one would combine Burbank with Banik (or any other reference for that matter) to alter the function of the knock out pin disclosed in Burbank.

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To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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